



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,815	12/28/1999	KI-HWAN KIM	678-418-(P88	1495

7590 07/17/2003

PAUL J FARRELL
DILWORTH & BARRESE
333 EARLE OVINGTON BLVD
UNIONDALE, NY 11553

EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,815

Applicant(s)

KIM, KI-HWAN

Examiner

Olisa Anwah

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2645

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Korea on December 28, 1999. It is noted, however, that applicant has not filed a certified copy of the Korean application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Akahane, U.S. Patent No. 6,226,533 (hereinafter Akahane).

Regarding claim 1, Akahane discloses a method for storing a voice message in a mobile telephone having a memory for storing

Art Unit: 2645

a voice message, comprising the steps of (a) determining whether a voice message store mode is set by a user; (b) calculating, when the voice message store mode is set, a remaining memory capacity, and starting storing a voice message in the memory while simultaneously displaying a length of the stored voice message, if the remaining memory capacity is sufficient to store the voice message; (c) after a predetermined time interval, recalculating the remaining memory capacity, and updating the displayed length of the stored voice message; (d) determining whether storing the voice message is completed, if the remaining memory capacity is sufficient to store the voice message, and returning to the step (c) if storing the voice message is not completed; and (e) upon completion of storing the voice message, calculating storage related information and storing the storage related information in the memory as voice message storage information for the stored voice message (col. 4, line 50 to col. 5, line 67).

Regarding claim 2, see col. 4, lines 50-65 and col. 5, lines 35-50.

Regarding claims 3 and 4, see col. 5, lines 65-67.

Art Unit: 2645

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al, U.S. Patent No. 6,169,911 (hereinafter Wagner) in view of Greco et al, U.S. Patent No. 5,568,540 (hereinafter Greco).

Regarding claim 5, Wagner discloses a method for reproducing a voice message in a mobile telephone having a memory for storing a voice message and storage-related information (see Figure 4), the method comprising the steps of (a) determining whether a voice message reproduce mode is set by a user; (b) accessing the memory to find the last stored voice message by consulting stored times of respective voice messages, when the voice message reproduce mode is set; (c) reproducing the found voice message; (e) determining whether a scroll key is input; and (f) finding a next voice message and returning to step (c) to reproduce the next voice message, if the scroll key

Art Unit: 2645

is input (lines 5-20 of column 3, lines 5-45 of column 5, lines 20-45 of column 6 and Figure 4).

Wagner does not disclose reproducing the found voice message while simultaneously displaying a remaining time left in the found voice message and after a predetermined time interval, updating the remaining time being displayed. However Greco discloses this limitation (see Figure 3). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wagner with the method of displaying remaining time as suggested by Greco. This modification would allow for a duration indicator as suggested by Greco and Wagner.

Regarding claim 6, see Greco, Figure 3.

Regarding claim 7, Wagner combined with Greco discloses (g) upon failure to detect the scroll key input, determining whether reproducing is completed; (h) upon completion of reproducing, determining whether the user intends to listen to the voice message again; (i) returning to step (c) if the user intends to listen to the voice message (see col. 6, lines 35-45).

Wagner combined with Greco does not disclose the limitation of "if the user does not intend to listen to the voice message again, determining whether the voice message is a last voice message; (j) ending the reproducing operation if the reproduced

Art Unit: 2645

voice message is the last voice message; and (k) finding a next voice message and returning to step (c) to reproduce the next voice message, if the reproduced voice message is not the last voice message". "Official Notice" is taken that this claimed limitation is both well known and old in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Wagner combined with Greco to include the claimed determining, ending and finding steps. This modification allows for all stored voice messages to be played.

Response to Arguments

6. Regarding claim 1, Applicant argues Akahane does not disclose calculating or storing storage-related information for a stored voice message. However according to Akahane, "As the user continues recording his or her message, the duration indicator display changes to indicate the amount of message memory capacity remaining available to user" (col. 5, lines 50-53). This duration indicator performs the claimed calculating feature. Therefore Akahane discloses calculating storage related information for a stored voice message. Applicant also argues Akahane only discloses determining available message time before commencement of message recording as opposed to determining

Art Unit: 2645

available message time during message recording. However Akahane discloses determining available time during recording (col. 5, lines 50-65). Therefore Akahane anticipates claim 1.

Applicant's arguments with respect to claims 5-7 have been considered but are deemed to be moot in view of the new grounds of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/473,815

Page 8

Art Unit: 2645

O.A.

Olisa Anwah

Patent Examiner

July 10, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written in a cursive style.